



Paper No. 7

SAMUEL H DWORETSKY
AT&T CORP
PO BOX 4110
MIDDLETOWN NJ 07748-411

COPY MAILED**OCT 3 1 2002****OFFICE OF PETITIONS**

In re Application of
Kapitskaia, et al.
Application No. 09/841,834
Filed: April 25, 2001
Attorney Docket No. 2000-0255

:
:
DECISION REFUSING STATUS
:
UNDER 37 CFR 1.47(a)
:

This is in response to the petition pursuant to 37 CFR 1.47(a),
filed February 12, 2002.

The petition under 37 C.F.R. 1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 C.F.R. 1.47(a)," and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the nonsigning inventor. **Failure
to respond will result in abandonment of the application.** Any
extensions of time will be governed by 37 C.F.R. 1.136(a).

The above-identified application was filed on April 25, 2001,
without an executed oath or declaration. Accordingly, on June
18, 2001, the Initial Patent Examination Division mailed a Notice
to File Missing Parts of Nonprovisional Application. This Notice
set a two month period for reply.

In reply, applicant filed the instant petition (and fee) and paid
the surcharge for late filing of the declaration. To make timely
this reply, applicant obtained a five month extension of time and
included a Certificate of Mailing dated January 18, 2002.
Applicant included a declaration signed by inventors Raymond Ng
and Divesh Srivastava. The declaration lacked a signature from
inventor Olga Kapitskaia.

On petition, attorney Benjamin Lee included a declaration of
facts from Felicia Adadevoh, the person having firsthand
knowledge of the efforts taken to transmit the application papers
to Kapitskaia. According to Adadevoh, the oath and declaration
"along with other papers" were forwarded to Kapitskaia via
Federal Express in late August, 2001. In addition, Adadevoh
states that no response as of the date of the petition has been
received, and the Federal Express package was not returned to
sender.

A grantable petition under 37 C.F.R. 1.47(a) requires: (1) proof
that the non-signing inventor cannot be reached after diligent
effort or refuses to sign the oath or declaration after having

been presented with the application papers (specification, claims, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 C.F.R. 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Rule 47 applicant has not met requirement (1) above.

As to requirement (1), applicant has not demonstrated that a copy of the entire application papers (specification, including claims and drawings) were sent for the nonsigning inventor's review. The record only establishes that a copy of the declaration was forwarded for signature. Requiring that an inventor be presented with the application papers before a petition under 37 C.F.R. 1.47 is granted "ensures that the inventor is apprised of the application to which the oath or declaration is directed."¹

Furthermore, the petition reveals that on January 18, 2002, Kapitskaia stated she would try to sign and return the declaration within a week's time. Accordingly, on renewed petition, Rule 47 applicant must either provide a copy of the executed declaration, or applicant must state that the declaration was never received.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.

Christina Patricia Donnell for

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹ MPEP 409.03(d).